

Notice of Allowability

Application No.

10/810,020

Examiner

Rodney P. Swartz, Ph.D.

Applicant(s)

LIN, HENRY C.

Art Unit

1645

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address-

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Response of 17October2005, Attorney authorization of 3January2006.
2. ☒ The allowed claim(s) is/are 1-12.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/837797.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 11/3/05
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____.
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

1. Applicant's Response to Office Action, received 17 October 2005, is acknowledged.

Claims 1, 3, 6, 7, 9, and 11 have been amended.

2. Claims 1-12 are pending and under consideration.

Objections/Rejections Withdrawn

3. The objection to the specification for "blank spaces" on page 31 is withdrawn in light of applicant's explanation.

4. The rejection of claims 1 and 2 under U.S.C. 112, second paragraph, for indefiniteness of "H" is withdrawn in light of the amendment of claim 1.

5. The rejection of claims 1-12 under U.S.C. 112, second paragraph, for indefiniteness for "peptide YY functional analogs" is withdrawn in light of the claim amendments.

6. The rejection of claims 1-12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Pat. No. 6,558,708 is withdrawn in light of the submitted Terminal Disclaimer.

7. The provisional rejection of claims 3 and 6 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 of copending Application No. 10/853,824 is withdrawn in light of the submitted Terminal Disclaimer.

Objections/Rejections Maintained

8. The objection to the specification priority statement is maintained.

Applicant argues that the Preliminary Amendment of 2 December 2004 contains the required update.

The examiner has considered applicant's argument, but does not find it persuasive because the status of Serial No. 09/374,142 has not been updated to recite that it is now U.S.

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Pat. No. 6861053 nor that Serial No. 09/420,046 is now abandoned nor that Serial No. 09/837,797 is now allowed.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Peter J. Knudsen, Reg. No. 40,682, on 3 January 2006.

The application has been amended as follows:

In the Specification:

Page 1, the priority claim is in error. Please amend to:

This application is a division of U.S. Patent Application Serial No. 09/837,797, filed April 17, 2001, **allowed**, which is a continuation-in-part of U.S. Patent Application Serial No. 09/374,142, filed on August 11, 1999, **and issued as U.S. Patent 6,861,053 on March 1, 2005**, and also a continuation-in-part of U.S. Patent Application Serial No. 09/374,143, filed on August 11, 1999, and issued as U.S. Patent 6,562,629 on 5/11/2003, and also a continuation-in-part of U.S. Patent Application Serial No. 09/546,119, filed on April 10, 2000 and issued as U.S. Patent No. 6,558,708 on May 6, 2003, which is a continuation-in-part of U.S. Patent Application Serial No. 09/420,046, filed October 18, 1999, **abandoned**, which is a continuation-in-part of U.S. Patent Application Serial No. 09/359,583, filed on July 22, 1999, abandoned, which was a continuation of U.S. Patent Application Serial No. 08/832,307, filed on April 3, 1997 and issued as U.S. Patent No. 5,977,175 on November 2, 1999, which was a continuation of

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U.S. Patent Application Serial No. 08/442,843, filed on May 17,1995, abandoned, and claims priority to PCT applications; PCT/01/1 1238 filed 04/07/2001; PCT/US00/22168 filed 8/1 1/2000; and PCT/US00/22030 filed 8/1 1/2000.

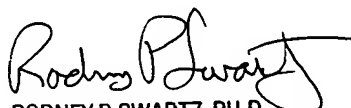
Conclusion

9. Claims 1-12 are allowed.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney P. Swartz, Ph.D., Art Unit 1645, whose telephone number is (571) 272-0865. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith, can be reached on (571)272-0864.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


RODNEY P. SWARTZ, PH.D.
PRIMARY EXAMINER

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January 3, 2006